UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,832	12/28/2000	Henry Hirschberg	Q041	8673

7590 05/31/2002

Daniel L. Dawes
MYERS, DAWES & ANDRAS LLP
5252 Kenilworth Dr.
Huntington Beach, CA 92649

EXAMINER
SHAY, DAVID M

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 05/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/750,832	Hirschberg
Examiner	Group Art Unit
A. Shay	3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on August 2, 2001.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-36 is/are pending in the application.

Of the above claim(s)____ is/are withdrawn from consideration.

☐ Claim(s)____ is/are allowed.

☑ Claim(s) 1-36 is/are rejected.

☐ Claim(s)____ is/are objected to.

☐ Claim(s)____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).____

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other____

Office Action Summary

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-15, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12-14 recite no further structure. In claim 15 exactly what constitutes an "amblulatory laser" is unclear. Claim 20 recites no further structures and what structure is intended to be recited by claim 21 is unclear.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 8, 10, 13-14, 19-23, 27, 28, and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dietrich et al.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5, 7, 9, 11, 12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietrich et al in combination with Chen et al.

Dietrich et al teaches a device as claimed except for the transparent plug; self sealing membrane and a laser which allows the patient to move about freely. Chen et al teach an indwelling PDT device including multiple lumens, a plug and a valve, and irradiation over a long period of time. It would have been obvious to employ the plugs and self sealing membranes claimed since these would enable the fluid to be retained in the balloon more easily and to provide low dosage PDT over a longer period of time, since this is more effective against the diseased tissue, as taught by Chen et al, or alternatively to form the spherical radiator of Chen et al as a balloon, since this enables more even illumination in the event the cavity is larger than the radiator and would further allow less traumatic removal and insertion of the device, thus producing a device such as claimed.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dietrich et al in combination with Chen et al as applied to claim 5,7, 9, 11, 12, and 15-17 above, and further in view of Hayman et al Hayman et al teach the desirability of combining PDT and radiation treatment. It would have been obvious to the artisan of ordinary skill to employ a radioactive wire, since this is a useful adjunct to PDT, thus producing a device such as claimed.

8. Claims 24-26, 29-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietrich et al in combination with Chen et al.

9. The teaching of Dietrich et al and Chen et al are, in addition to those set forth above set forth above, the total implantation of the irradiator by Chen et al. Thus it

would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to produce a method such as claimed and to prolong the treatment over the course of months or a year, since some cancers are very difficult to irradicate, thus producing a method such as claimed.

10. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dietrichin combination with Chen et al as applied to claims 24-26, 29-31 and 34-36 above, and further in view of Hayman et al The teachings of Hayman are essentially and the motivations for combination thereof are essentially those set forth above. Thus it would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to produce a method such as claimed.

Any inquiry concerning this communication should be directed David Shay at telephone number (703) 308-2215

David Shay:bhw

April 26, 2002

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330